

**REMARKS**

Applicants hereby traverse the outstanding rejections, and request reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1-20 are pending in this application.

**Rejections under 35 U.S.C. § 112, second paragraph**

Claims 1-15 and 17 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Specifically, the language in claims 1, 2, and 17 is asserted by the Office Action as being unclear. Claims 3-8 are rejected as being dependent from a rejected base claim. In response, Applicants have redrafted portions of claims 1, 2, and 17 to more clearly define the invention stated therein. Claims 1-8 have also been amended to remove the references to step or steps. Claim 3 has been amended to correct minor grammatical errors. Claims 6-7 have been amended to remove references to “run time”. The claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph or to correct grammatical errors, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered. As each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment, Applicants respectfully request the rejection of claims 1-8 and 17 under 35 U.S.C. § 112, second paragraph be withdrawn.

Claims 9 and 10 are rejected as having unclear language. Claims 11-14 are rejected as being dependent from a rejected base claim. Applicants respectfully request the Examiner reconsider this rejection, as Applicants assert that the claim language of claim 9 is clear and unambiguous. Claim 9 states that the “work requests” are “affecting data stored in said at least one hierarchical storage device”, thus the work requests are associated with the at least one hierarchical storage device. Claim 10 has been amended to clarify that the work requests that are stored in the request queue may be coming from the host device and/or the at least one hierarchical storage device. As each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment or argument, Applicants respectfully request the rejection of claims 9-14 under 35 U.S.C. § 112, second paragraph be withdrawn.

Claim 15 has been amended to correct its dependency. Applicants respectfully request the rejection of claim 15 under 35 U.S.C. § 112, second paragraph, be withdrawn.

**Rejections under 35 U.S.C. § 103**

Claims 1, 3-5, 9-12, and 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Belhadj et al. ('425, hereinafter Belhadj) in view of Courtright, II et al. ('963, hereinafter Courtright).

Claims 2, 6-8, 13-15, and 19-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Belhadj in view of Courtright, further in view of Pecone et al. ('123, hereinafter Pecone).

Applicants respectfully assert that Belhadj is not a valid prior art reference. As amended by the American Inventor's Protection Act of 1999 (the Act), signed on November 29, 1999, section 103(c) now states:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of sub-sections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis added).

Section 4807 of the Act further provides that this new provision applies to any application filed on or after the date of enactment, November 29, 1999. The filing date of this application is after the effective date of the new law.

The Examiner will note that Belhadj, and this application are assigned to the same entity, namely Hewlett Packard Company. Belhadj was filed before, but did not issue until after the current application's filing date. Therefore, the disclosure of Belhadj is available only as 35 U.S.C. § 102(e)-type prior art. In that regard, 35 U.S.C. § 103(c) now provides that Belhadj shall not preclude patentability of the claimed invention.

To establish a prima facie case of obviousness, three basic criteria must be met. See M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, or that the rejection of record is sufficient to establish obviousness under 35 U.S.C. § 103, Applicants assert that, without the elements found in Belhadj, the remaining references of record cannot be relied upon teach or suggest all of the claim limitations as noted above.

Applicants, therefore, respectfully submit that claims 1-20 are patentable and non-obvious under 35 U.S.C. § 103(a) over the art of record, and that these claims are in condition for allowance.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

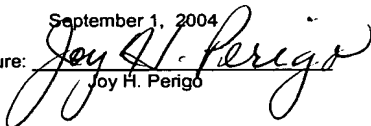
Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003127-1 from which the undersigned is authorized to draw.

Dated: September 1, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482734315US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: September 1, 2004

Signature:

  
Joy H. Perigo

Respectfully submitted,

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